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Remarks

Claims 1 through 4 and 7 through 10 remain pending in the application.

The examiner has rejected claims 1 through 4 and 7 through 10 as obvious over McCook, Recreational Printing Device, U.S. Patent 5,980,351 (Nov. 9, 1999) in combination with Conrad, Dough Cutter with Interchangeable Cutting Elements, U.S. Patent 4,327,489 (May 4, 1982).

The Office Action has failed to provide a motivation to modify the reference. The examiner states that it would have been obvious to combine the teachings of McCook and Conrad to provide a method of stamping snow or sand which provides an imprint of a desired shape with a modicum of force by the cookie cutter. The Office Action has merely stated that it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide blades to a device to imprint snow. However, the Examiner does not identify why an element found on a cookie cutting device would be desirable for an toy used on sand or snow. Thus, the office action does not state a prima facie case of obviousness.

The Office Action states that the blade dimensions are is considered "obvious engineering." The Examiner's conclusion that the blade dimensions are merely "obvious engineering" is unfounded and improper as a substitute for the required analysis of patentability. The case of Graham v. John Deere Co., 383 U.S. 1 (1966), eliminates application of all such maxims in favor of the mandated test for patentability. The rejection based on "obvious engineering" appears to be offered as a substitute for the test required by Graham v. John Deere, which is improper. Graham v. John Deere requires identification of some pre-existing motivation

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to combine prior art references to achieve the claimed combination. The mere statement that, in any one persons opinion, a given element is merely "obvious engineering" does not accomplish the legally required inquiry. There is no rational basis for application of such an assertion, and thus the assertion deprives the applicant of his right to have her application considered under uniform standards on par with all other applicants. Accordingly, the rejection should be withdrawn absent some identification of a motivation to make the claimed invention with its "obvious engineering" features.

Conrad is non-analogous art. A person skilled in the art of cookies would not use the McCook foot or hand strapping device as a template for cutting out cookie shapes. Conversely, a person skilled in the art of sand imprinting would not look to a cookie cutter to find motivation for making imprints in the sand. These media are not similar in composition, nor are they closely related. Thus, Conrad should be ignored, and any rejections based on Conrad should be withdrawn.

Even if combined, the resulting combination does not meet all of the claims of the limitations. Applicant's claims require that the blade have a thickness of about .125 inches and a minimum depth of about .03125 inches. Furthermore, Claims 1, 4, 7, and 10 require that the blades be separated from adjacent detail blades by a minimum distance of about .045 inch. These dimensions were chosen to make detailed imprints in the sand. These blade dimensions are not present in McCook as the "printing indicia" in McCook are defined to be flat broad indicia. The blocks with embedded flat indicia are stable enough so that a user can walk erect while wearing the blocks and make images in soft ground or sand. Applicant's blades are not likely to be contained on the McCook device because the blades would not provide the appropriate stability and support for the wearer to be able to walk upright.

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McCook's indication that the indicia are flat so that a user can walk erect while wearing his blocks directly teaches against the claimed combination. Applicants claimed blades are not broad and flat, so that the advantage of McCook is lost. Thus, McCook provides an explicit motivation to avoid the claimed combination. Thus, the claims are non-obvious.

With regard to Conrad, Conrad does not claim blades of any particular thickness, height, or distance apart from each other. The distance defined within Applicant's claims is ideal for ensuring that enough grains of sand can appropriately fit in between the blades to leave a marking within the sand. Conrad only identifies that it is preferred that the impressing walls have a height less than the height of the ribs so that a cut is not made completely through the dough (column 2, line 58). Because Applicant's blades are not used to cut through a dough-like substance to form a three-dimensional object, the appropriate blade thickness, height, and distance apart are different than that required to leave an impression on dough-like material. The critical dimensions of Applicant's blades are specified such that the device when imprinted in sand or snow will form clean imprints in the desired medium. The critical dimensions are not needed or are different in Conrad because the device forms 3-dimensional objects, not imprinted designs. Also, Conrad's media, cookie dough, comprises a familiar moist, adhesive, coherent aggregate (or in some cases, a polymer) with completely different structural behavior compared to beach sand, which of course has no structural integrity at all. Further, the cookie dough rises and the details would be blurred or obliterated by the baking process not inherent in Applicant's invention, and thus dimensions suitable for impressing cookie dough bear no discernable relation to the dimensions that might be useful for imprinting sand. There are so many variables that might come into play that any insights gleaned are of no value at the beach.

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The prior art references do not contain any suggestion that they be combined in the manner suggested by the Examiner. The Examining Attorney argues that the deficiency of providing detail blades to imprint more details or better imaging with a modicum of effort is found in Conrad who teaches imprinting with a die cutter with detail blades in a soft surface such as dough. The Conrad cookie cutter discloses blades that are spaced at certain distances apart to create more detail to a cookie. The greater amount of detail is attainable because the cutter imprints a desired shape onto an entirely different medium. For example, where a dough-like substance is used, the imprinted dough is picked up by a user and placed on a surface for baking. The cutter can accommodate for more detail because the surface into which the cutter is being positioned is capable of maintaining a greater amount of detail. The McCook indicia instead make a mark on a soft grainy surface. The surface on which the mark is made is not capable of being handled by a user. The mark is made merely for the enjoyment of the user while playing on the soft surface. There is no suggestion to combine features of a cookie cutter, intended for cutting detailed dough prior to baking of, with soft surface imprinting indicia. It is unsuggested to combine a cookie cutter with a footwear block toy.

The Applicant's invention possesses unappreciated advantages and results in unexpected results that up to now those skilled in the art have never appreciated. Applicant has tested various types of indicia and their effectiveness at leaving an imprint on the desired medium. The devices with blades, as described in the claims, left the distinct markings with clear outlines and internal detail in dry and wet sand. Devices with broad flat indicia similar to McCook's left indistinct outlines with no discernable internal detail. The use of the blades for marking in the sand or snow has results in a clear, detailed marking. To make the mark, a small amount of force need be exerted to the device. Even a young child can make clear, vivid marks with

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minimal effort. The use of the blade achieves superior results that cannot be achieved with McCook's device.

The invention described in Conrad is not within the scope of the art for one skilled in the art of making designs in the sand. One skilled in the art of practicing a method of imprinting sand or snow with a sand die is likely between the ages of 2 and 10 years old. One skilled in the art of cooking is likely older than 10 years old because of the potential dangers associated with the use of kitchen appliances. Therefore, these do not require the same skill in the art, and one of ordinary skill in the art of playing in the sand may very well have no exposure to the art of cookie manufacture.

The references themselves are individually complete. Both of the references cited by the Examining Attorney are complete and functional by themselves. Therefore, there would be no reason to use elements or parts from or ass or substitute parts to either of the references.

Finally, the problem solved by the invention has never before been recognized, and the recognition of an unrecognized problem militates in favor of patentability. Applicant's experimentation with use of McCook like devices has demonstrated that flat broad indicia do not provide clear marks within sand. In order to obtain marks with the greatest amount of detail, it is necessary to use blades as in Applicant's device. If in fact the Conrad cookie cutter were used to make the footwear or handwear blocks of McCook, the fact that use of such indicia is not even mentioned or suggested militates in favor of patentability. Furthermore, if the invention were in fact obvious, because of its advantages, those skilled in the art surely would have implemented it by now. The Conrad cookie cutter patent has been around since 1982 while the device in McCook has been around since 1999, and kids have been playing in the sand for since time immemorial. The fact that those skilled in the art in McCook have not implemented the

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invention, despite its great advantages, indicates that it is not obvious.

Conclusion

This response has addressed all of the Examiner's grounds for rejection. The rejections based on prior art have been traversed. Reconsideration of the rejections and allowance of the claims is requested.

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